



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. MBHB00-516)

In the Application of:

Risto Makipaa

Serial No.: 09/604,596

Filed: June 27, 2000

Title: Centralized Management of  
Telecommunications Parameters

Art Unit: 2683

Examiner: Lee Nguyen

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF A. BLAIR HUGHES**

I, A. Blair Hughes, a citizen of the United States and having a residence at 822 West Webster Avenue, Chicago, Illinois 60614, USA to declare as follows:

1. I am an attorney at the law firm of McDonnell Boehnen Hulbert & Berghoff LLP with an office at 300 S. Wacker Drive, Chicago, Illinois, 60606. I am registered to practice before the U.S. Patent and Trademark Office. My registration number is 32,901.

2. On June 27, 2000 I caused the above-identified application to be filed with the U.S. Patent Office. The application was given serial number 09/604,596 (hereinafter "the '596 application") by the U.S. Patent Office.

3. The '596 patent application Assignee is Domiras Oy. An Assignment of the application is recorded at reel 011167, frame 0213.

4. AT all times I have received instructions regarding the prosecution of the '596 application from employees of Kolster Oy AB, Domaris Oy's Finnish law firm.

5. In addition to the '596 application and on instructions from Kolster Oy, I filed 5 other patent applications assigned to Domiras Oy with the U.S. patent office from January 12, 2000 to November 30, 2001. Information about the 5 Domiras Oy patent applications is summarized below:

U.S. Patent Application S.N.	U.S. Patent Application Filing Date	MBHB Docket Number
09/462,761	January 12, 2000	99-922
09/800,750	March 7, 2001	01-187
09/804,862	March 13, 2001	01-186
09/980,195	November 30, 2001	01-1727
10/032,905	November 1, 2001	01-1602

5. I received a June 14, 2002 letter from Kolster Oy (See Exhibit A) advising me that further prosecution of the '596 patent application as well as the 5 applications identified in Paragraph 4 above was under consideration. The letter further instructed to me not to incur further expenses and not to work on the application files without written authorization from Kolster Oy. Finally, the letter advised me to send a copy of any Official Letter issued by the U.S. Patent Office for any of the applications to Kolster Oy. I followed the instructions in the letter.

6. I received a letter dated August 8, 2002 from Kolster Oy (See Exhibit B) instructing me to allow the '596 application and the 5 applications listed in Paragraph 4 above to lapse without incurring additional fees. I relayed Kolster Oy's instructions to our docketing department manager and the status of the '596 application and the 5 applications listed in paragraph 4 above was changed from "filed" to "abandoned" in McDonnell Boehnen Hulbert & Berghoff's electronic docketing system.

7. On about October 7, 2002 I received an Official Action dated October 1, 2002 for

the '596 application. I did not forward a copy of the Official Action to Kolster Oy. A response deadline for the Official Action was not docketed because of the "abandoned" status of the application in the firm electronic docketing system.

8. On December 20, 2002 I received a letter from Kolster Oy indicating that a third party might be interested in acquiring the '596 application and the 5 applications listed in paragraph 4 - the 6 of the applications that Kolster Oy Ab had previously instructed me to allow to lapse in the August 8, 2002 letter. In the December 20, 2002 letter, Kolster Oy Ab inquired about the status of each of the six patent applications. A copy of the Kolster Oy Ab December 20, 2002 letter is attached at Exhibit C.

9. On December 20, 2002, I prepared and sent a letter to Kolster Oy Ab advising them of the status of each of the six applications that they had previously instructed me to allow to go abandoned. In my letter, I advised Kolster Oy that all six applications including the '569 application remained pending. Moreover, I indicated that one of the applications - U.S. application serial number 09/800,752 - had an Office Action outstanding. (See Exhibit D)

10. In my December 20, 2002 letter I did not advise Kolster Oy Ab that an Official Action was outstanding for the '596 application. This was an oversight on my part that I believe was a result of my reviewing the electronic docket for the case instead of the application file to determine the case status. As a result of this oversight, I did not make Kolster Oy Ab aware of the existence of the October 1, 2002 Official Action for the '596 application on December 20, 2002. As of December 20, 2002, there remained time to respond to the October 1, 2002 Official Action issued in the '596 application.

11. On about July 1, 2003, I received a Notice of Abandonment of the above-

identified patent application. I did not forward a copy of the Notice of Abandonment to Kolster Oy and upon information and belief, Kolster Oy was not aware of the abandoned status of the '596 application.

### **Subsequent Treatment of Domiras Oy Ab Patent Applications**

12. Despite the August 8, 2002 instructional letter from Kolster Oy to allow the '596 application and the patent applications listed in paragraph 4 above to lapse, it was my intent to send copies of all official actions issued by the U.S. Patent Office for the six Domiras Oy Ab applications, including the '596 application to Kolster Oy as a courtesy and to requested response instructions from them for each case. (*See e.g.*, Letter attached as Exhibit E).

13. As proof of my intention, I have prepared a table below identifying, by application, (i) the date an official action was issued in each of the applications identified in Paragraph 4 above; (ii) the approximate date that I notified Kolster Oy Ab of an official action; (iii) the date I received response instructions from Kolster Oy Ab; and (iv) a summary of the response instructions.

Application No.	Date of First Official Action	Date Official Action Conveyed to Kolster Oy Ab	Date of Kolster Oy Ab's response instructions	Response Instructions
09/462,761	February 27, 2003	March 6, 2003	May 15, 2003	Respond to Official Action – Note Application Prosecution Still Ongoing
09/800,750	Nov. 6, 2002	Dec. 20, 2002	March 7, 2003	Allow to Lapse
09/804,862	Sept. 21, 2004	October 1, 2004	December 20, 2004	Allow to Lapse
09/980,195	Awaiting First Official Action			
10/032,905		Sept. 15, 2004	March 1, 2005	Allow to Lapse

14. At all times it was my intent to treat the '596 application identically to the 5 patent applications listed above by sending Kolster Oy any office actions issued in the '596 application and thereafter seeking response instructions.

#### **Discovery Of Application Abandonment**

15. On October 27, 2005 I received an email communication from Kolster Oy Ab requesting information about the status of the '596 patent application. In my email response dated October 31, 2005 I notified Kolster Oy Ab, for the first time, that the '596 application became abandoned on January 2, 2003 for failure to respond to the October 1, 2002 Official Action. (Exhibit F)

16. On November 4, 2005, I sent a copy of the October 1, 2002 Official Action for the '596 application to Kolster Oy for the first time.

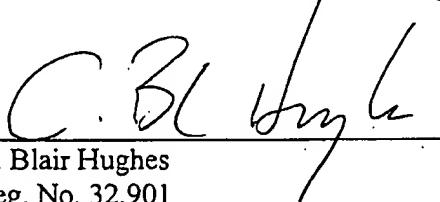
17. On November 28, 2005 I received a letter from Kolster Oy instructing me to take steps necessary to file a Petition of Revive the '596 application on the basis that it was unintentionally abandoned. Since November 28, 2005, I have worked diligently to collect relevant documents, to prepare the required petition, accompanying declarations, exhibits and to prepare a response to the outstanding official action for the '596 application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true; and further that these statements were made with the knowledge that will false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

Respectfully submitted,

**McDonnell Boehnen Hulbert & Berghoff LLP**

A handwritten signature in cursive script, appearing to read "C. Bl Hughes", is written over a horizontal line.

A. Blair Hughes  
Reg. No. 32,901  
312-913-2123

Date: January 17, 2006



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KOLSTER

MCDONNELL BOEHNNEN  
HULBERT & BERGHOFF  
32 ND FLOOR  
300 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
USA

Attn: Mr A. Blair Hughes

FAX: 3129130002, original by mail

Helsinki, 14 June 2002

Re: U.S. Patent Applications in the name of Domiras Oy

Dear Mr Hughes:

This is to inform you that the ownership of patent applications in the name of Domiras Oy might change in the near future and that the further prosecution of the applications is under consideration. For your convenience, we have attached a list of the applications that are handled by your office.

Kindly incur no further expenses and do no work on these files without written authorisation from us. However, in case an official letter is issued, please send us a copy thereof at minimum costs. We will return to the matter as soon as we have received our client's final instructions.

Please confirm the receipt of this letter by return telefax and send us your debit note for outstanding costs, if any, by 5 July 2002 at the latest.

Thank you for your assistance in this matter.

Yours faithfully,

KOLSTER OY AB

*Lenita Lindroos*  
Lenita Lindroos

Encl.

KOLSTER OY AB

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Stora Robertsgatan 23  
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FIN - 00121 Helsinki - Helsingfors

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Perustettu • Grundad • Established 1874  
Y-tunnus • FO-nummer • Business ID 0110129-2

Toimistot • Kontor • Offices:  
Helsinki • Helsingfors  
Turku • Åbo  
Tampere • Tammerfors  
Vaasa • Vasa



KOLSTER



**DOMIRAS OY**

<u>Kolster's ref.</u>	<u>Appln No.</u>	<u>Applicant</u>	<u>Your ref:</u>
2000222US	09/980,195	DOMIRAS OY	01-1727
2000349US	09/604,596	DOMIRAS OY	00-516
2970932US	09/462,761	DOMIRAS OY	99,922
2980443US	09/800,750	DOMIRAS OY	01-187
2990003US	09/804,862	DOMIRAS OY	01-186
2990168US	10/032,905	DOMIRAS OY	01-1602





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00-516

MC DONNELL BOEHNEN  
HULBERT & BERGHOFF  
32 ND FLOOR  
300 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
USA

Attn: Mr. A. Blair Hughes

FAX: 3129130002, original by mail

Helsinki, 8 August 2002

**RE: Abandonment of U.S. Patent Applications**  
**Applicant: Domiras Oy**

Dear Mr Hughes,

Referring to our letter of 14 June 2002 we inform you that the Applicant has now decided to abandon the patent applications as identified on the enclosed list. Therefore, please let these applications lapse without incurring further costs.

Please confirm the receipt of this letter.

Yours faithfully,

KOLSTER OY AB

Anita Kantola

Encl. /1 page

KOLSTER OY AB

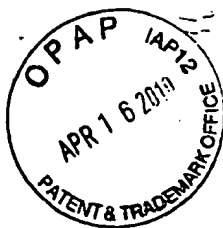
Iso Roobertinkatu 23  
• Stora Robertsgatan 23  
PL - PB - PO Box 148  
FIN - 00121 Helsinki • Helsingfors  
kolster@kolster.fi

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fax +358 (0)9 602 244  
tel +358 (0)9 618 821

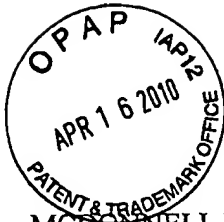
Perustettu • Grundad • Established 1874  
Y-tunnus • FO-nummer • Business ID 0110129-2  
Kotipaikka • Hemort • Reg. Office Helsinki • Helsingfors

Toimistot • Kontor • Offices:  
Helsinki • Helsingfors  
Turku • Åbo  
Tampere • Tammerfors  
Vaasa • Vasa  
Oulu • Uleåborg



## DOMIRAS OY

<u>Kolster's ref.</u>	<u>Appln No.</u>	<u>Applicant</u>	<u>Your ref.</u>
2000222US	09/980,195	DOMIRAS OY	01-1727
2000349US	09/604,596	DOMIRAS OY	00-516
2970932US	09/462,761	DOMIRAS OY	99,922
2980443US	09/800,750	DOMIRAS OY	01-187
2990003US	09/804,862	DOMIRAS OY	01-186
2990168US	10/032,905	DOMIRAS OY	01-1602



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32 ND FLOOR  
300 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
USA

Attn: Mr. A. Blair Hughes

URGENT!

FAX: 3129130002, original by mail

Helsinki, 20 December 2002

RE: Revival of abandoned U.S. Patent Applications  
Applicant: DOMIRAS OY

DOCKETED

DEC 30 2002

DUE DATE: —  
BY: KB

Dear Mr. Hughes,

We refer to our letter of August 8, 2002 instructing you to abandon all U.S. patent applications handled by your firm on behalf of our client, Domiras Oy.

In your letter of August 8, 2002 you kindly confirmed receipt of our instructions and informed us that you will close your files for each of the six cases (cf. the enclosed list) and that you will incur no further expenses.

However, our client is now in negotiation on company acquisition and we would like to know whether or not any of said six applications can be revived anymore? We look forward to your response at your very earliest convenience.

With kind regards and all good wishes for Christmas and the New Year,

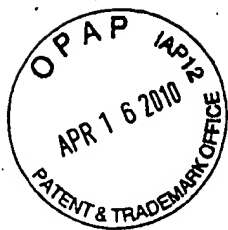
Very truly yours,

KOLSTER OY AB

  
Anita Kantola

Encl. List

KOLSTER



**DOMIRAS OY**

<u>Kolster's ref.</u>	<u>Appln No.</u>	<u>Applicant</u>	<u>Your ref:</u>
2000222US	09/980,195	DOMIRAS OY	01-1727
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2990168US	10/032,905	DOMIRAS OY	01-1602



McDonnell Boehnen Hulbert & Berghoff  
Law Offices

300 South Wacker Drive  
Chicago, Illinois 60606-6709  
www.mbhb.com

312 913 0001 phone  
312 913 0002 fax

***Via Facsimile  
Confirmation by Mail***

December 20, 2002

Anita Kantola  
Kolster Oy Ab  
P.O. Box 148  
FIN-00121 Helsinki  
FINLAND

**Re:** Revival of Abandoned of U.S. Patent Applications  
Applicant: Domiras Oy

Dear Anita:

We are in receipt of your December 20, 2002 facsimile letter inquiring about the status of six Domiras Oy U.S. patents applications that you previously instructed us to allow to lapse.

It is my practice not to expressly abandon U.S. patent applications unless instructed to do so by a client. Therefore, I am happy to report that all six U.S. patent applications that you identified in your letter are currently active and pending before the U.S. Patent Office. We received an Official Action on November 6, 2002 for the application bearing our case number 01-187 (your reference 2980443US). A Response to the Official Action must be filed with the U.S. Patent Office by February 6, 2003 in order to avoid incurring late fees. The absolute deadline for responding to the Official Action is May 6, 2003. There are no other deadlines to report for the six listed applications.

At this time we are not actively monitoring the status of any of the six U.S. patent applications listed in your letter. Please let us know if you would like us to reactivate these applications on our docketing system. Please let also let us know if you would like us to send you a copy of the U.S. Official Action and cited prior art for case number 01-187.

Very truly yours,



A. Blair Hughes  
312-913-2123  
hughes@mbhb.com

ABH;jlj  
Enclosure



McDonnell Boehnen Hulbert & Berghoff  
Law Offices

300 South Wacker Drive  
Chicago, Illinois 60606-6709  
www.mbhb.com

312 913 0001 phone  
312 913 0002 fax

***Via Facsimile  
Confirmation by Mail***

March 6, 2003

Anita Kantola  
Kolster Oy Ab  
P.O. Box 148  
FIN-00121 Helsinki  
FINLAND

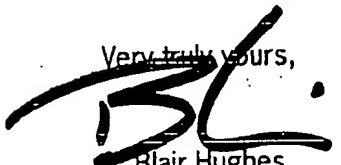
**RE:** U.S. Patent Application  
Method and Terminal for Providing Services in Telecommunication Network  
Applicant: Domiras Oy  
Your Ref. No. 2970932US/Pg/lei  
MBHB Case No. 99,922

Dear Ms. Kantola:

As a courtesy, we wish to notify you that we received the enclosed Official Action from the U.S. Patent Office for the above-captioned U.S. patent application. All application claims stand rejected for lack of novelty.

You previously instructed us to allow the above-captioned application to go abandoned. We will take no further action in this matter unless you instruct us to the contrary.

Very truly yours,

  
A. Blair Hughes  
312-913-2123  
hughes@mbhb.com

ABH;jlj  
Enclosure



**Hughes, Blair**

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**From:** Pulkka, Tuula [Tuula.Pulkka@kolster.fi]  
**Sent:** Friday, October 28, 2005 6:00 AM  
**To:** Hughes, Blair  
**Subject:** Revival of US appln 09/604,596  
**Importance:** High

Your ref: MBHB00-516  
Our ref: 2000349US

Dear Mr. Hughes:

we have instructed you to abandon the above-identified patent application in our letter of August 8th, 2002. Now it seems that the abandonment was unintentional. Due to transfer of rights etc the Client's instructions were apparently not correct or there was a misunderstanding.

Is there any possibility to revive this case?

Thank you in advance for your early reply.

With best regards,

Tuula Pulkka, Ms.  
Head of Dept., Foreign Patents  
Kolster Oy Ab  
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